UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,118	08/08/2003	Brian Dorricott	28489/39573	3822

4743   7590   08/01/2007

MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER
CHEEMA, UMAR

ART UNIT	PAPER NUMBER
2144	

MAIL DATE	DELIVERY MODE
08/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 May 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5 and 11-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5 and 11-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 May 2007</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This actions is response to the Amendment filed on 29 May 2007. Claims 1-5

and 11-22 are pending with claims 1, 21 and 22 being the independent claims. Claims

1, 11, 16, 21 and 22 have been amended. Claims 6-10 have been cancelled.

Applicant's arguments, see remarks, filed 05/29/2007, with respect to the

Drawings and Specification have been fully considered and are persuasive. The

objections to the Drawing and Specification have been withdrawn.

Applicant's argument, see remarks, field 05/29/2007, with respect to claim 22

previously rejected under 35 U.S.C §101 as being directed to non-statutory subject

matter has been fully considered and is persuasive. The rejection to claim 22 has been

withdrawn.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a
person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived
by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Giroux et al (US 6,782,003) in view of Greenspan et al (US 6,850,484).

Regarding **claim 1,** Giroux et al teach a method of transferring users' email accounts

(col. 5, lines 14-16) from a source server to a destination server (abstract), the method

comprising: setting up the destination server to act as a gateway transferring e-mail

connections to the source server; and when the user logs on the first time, setting up

the destination server to automatically collect the information entered by the user at log

on (col. 10, lines 44-50) and to initiate the transfer of the user's mail folders and its

contents from the source server to the destination server (fig. 4b(450), col. 6, lines 57-

63).

Giroux et al **do not teach setting up destination server to act as a gateway** in their

disclosure.

However in the same field of endeavor Greenspan et al teach the stream

manager that can include a computer based router or server that behaves as if it were a

gateway for a sub-network of destination site servers (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Giroux et al teaching and Greenspan et al teaching for transferring email accounts from source server to destination server where destination server acts as a gateway. It is true because gateway is a common protocol used for a software or hardware communications.

Regarding **claim 2,** Greenspan et al teach a method as claimed in claim 1, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (col. 3, lines 5-10).

Regarding **claim 3,** Giroux et al teach a method as claimed in claim 2, further comprising retiring the source server once all e-mail accounts have been transferred (fig. 4a, col. 6, lines 12-15).

Regarding **claims 4-5,** the combination of Giroux et al and Greenspan et al teach a method as claimed in claim 1, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 4, further comprising retiring the source server once all e-mail accounts have been transferred (Giroux: fig. 4a, col. 6, lines 12-15).

Regarding **claims 6-10** (Cancelled).

Regarding **claim 11,** Giroux et al teach a method as claimed in claim 6, further comprising initiating the transfer of the user's mail folder when each user logs on for the first time before the destination server services the user (col. 6, lines 47-62, fig. 5(500), col. 5, lines 54-60).

Regarding **claim 12,** Greenspan et al teach a method as claimed in claim 11, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (col. 3, lines 5-10).

Regarding **claim 13,** Giroux et al teach a method as claimed in claim 12, further comprising retiring the source server once all e-mail accounts have been transferred (fig. 4a, col. 6, lines 12-15).

Regarding **claims 14-15,** the combination of Giroux et al and Greenspan et al teach a method as claimed in claim 11, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 14, further comprising retiring the source server once all e-mail accounts have been transferred (Giroux: fig. 4a, col. 6, lines 12-15).

Regarding **claim 16,** Giroux et al teach a method as claimed in claim 6, further comprising: causing the destination server to pass the e-mail connection through to the source server when each user logs on for the first time; and transferring the user's mail folder once the user has logged off (col. 6, lines 47-62, fig. 5(500), col. 5, lines 54-60).

Regarding **claim 17,** Greenspan et al a method as claimed in claim 16, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (col. 3, lines 5-10).

Regarding **claim 18,** Giroux et al teach a method as claimed in claim 17, further comprising retiring the source server once all e-mail accounts have been transferred (fig. 4a, col. 6, lines 12-15).

Regarding **claims 19-20,** the combination of Giroux et al and Greenspan et al teach a method as claimed in claim 16, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 19, further comprising retiring the source server once all e-mail accounts have been transferred (Giroux: fig. 4a, col. 6, lines 12-15).

Regarding **claim 21,** Giroux et al teach an apparatus for transferring users' e-mail

accounts (col. 5, lines 14-16) from a source server to a destination server (abstract), the

apparatus comprising:

a source server on which is set up the e-mail accounts (col. 3, lines 30-35) ; and a

destination server arranged to receive e-mail accounts as they are transferred from the

source server (abstract, col. 3, lines 30-35), arranged as a gateway transferring e-mail

connections to the source server, and further arranged such that, when the user logs on

for the first time, it automatically collects the information entered by the user at log on

(col. 10, lines 44-50) and initiates the transfer of the user's mail folder and its contents

from the source server to the destination server (fig. 4b(450), col. 6, lines 57-63).

Giroux et al **do not teach gateway transferring e-mail connections** in their

disclosure.

However in the same field of invention Greenspan et al teach a system manager

that can include a computer based router or server that behaves as if it were a gateway

for a sub-network of destination site servers, and the stream manager is linked to a

packet network, such as the internet (abstract).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine Giroux et al teaching and Greenspan et al teaching for

transferring e-mail accounts. It is true because gateway is a common protocol to use

for a software and hardware communication.

Regarding **claim 22** Giroux et al teach a computer program product (col. 7, Software Architecture) for transferring users' e-mail accounts from a source server to a destination server, the computer program product comprising a computer readable program code configured to cause the destination server to act as a gateway transferring e-mail connections to the source server (abstract, fig. 4a-b, col. 7, lines 10-13), and, when the user logs on the first time, to cause the destination server to automatically collect the information entered by the user at log on (col. 10, lines 44-50) and to initiate the transfer of the user's mail folders and its contents from the source server to the destination server (fig. 4b(450), col. 6, lines 57-63).

Giroux et al **do not teach destination server to act as a gateway** in their disclosure.

However in the same field of endeavor Greenspan et al teach the stream manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Giroux et al teaching and Greenspan et al teaching for a computer program product for transferring email accounts from source server to destination server where the computer program product comprising a computer readable program code configured to cause destination server acts as a gateway transferring e-mail connections to the source server. It is true because gateway is a common protocol used in any software or hardware communications.

Response to Arguments

3.   Applicant's arguments filed May 29, 2007 with respect to claims 1-5 and 11-22

have been fully considered but they are not persuasive.

        Applicant argues, see remarks, field 05/29/2007, **"none of claims 1-5 or 11-22**

are rendered unpatentable over Giroux et al. in view of Greenspan et al., because

neither Giroux et al. nor Greenspan et al. disclose automatically collecting

information entered by the user at logon and initiating the transfer of the user's

mail folder and its contents from the source server to the destination server."

        In response to the preceding argument, Examiner respectfully refers that Giroux

does disclose automatically collecting information entered by the user at logon (see col.

10, lines 44-50; automatically log) and initiating the transfer of the user's mail folder and

its contents from the source server to the destination server (see fig. 4b(450), col. 6,

lines 57-63).

        Likewise, Greenspan et al. discloses automatically collecting information entered

by the user at logon and initiating the transfer of the user's mail folder and its contents

from the source server to the destination server (see col. 3, lines 2-5; the destination

server may respond automatically, may store the received message, or may forward the

message).

        Therefore, the combination of Giroux et al. and Greenspan et al. does disclose or

suggest all of the limitations of claims 1-5 and 11-22 for the reason above.

Conclusion

4.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

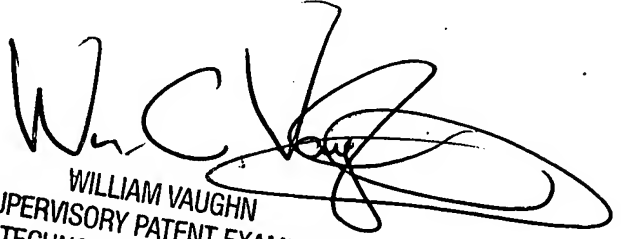than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Umar Cheema whose telephone number is 571-270-

3037. The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, William Vaughn, Jr. can be reached on 571-272-3922. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

uc

WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100